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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/121,300	07/23/1998	BRUCE G. KANIA	OHI 1717-096	3160
8698 7590 06/20/2007 STANDLEY LAW GROUP LLP 495 METRO PLACE SOUTH SUITE 210 DUBLIN, OH 43017			EXAMINER WILLSE, DAVID H	
			ART UNIT 3738	PAPER NUMBER
			MAIL DATE 06/20/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/121,300

Applicant(s)

KANIA ET AL.

Examiner

Dave Willse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 2, 2007, and May 3, 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 75-78, 80, 85, 88, 89, 92-94, 96, 99, 102, 103, 106, 107, 110, 111, 114, 115, 118-121, 124-165 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☒ Claim(s) See Continuation Sheet is/are allowed.
- 6) ☒ Claim(s) 78, 134, 143, 152 and 161 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 5-2-07 (3 pages).
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

Continuation of Disposition of Claims: Claims allowed are 75-77,80,85,88,89,92-94,96,99,102,103,106,107,110,111,114,115,118-121,124-133,135-142,144-151,153-160 and 162-165.

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In regard to the Information Disclosure Statement of May 2, 2007, the file copy of the prosthetic catalog (dated 1994) of Pel Supply Co. is barely legible, and the Applicant is requested to provide a clearer copy of said document if available. The cited Silipos Silosheath advertisement in *O & P Business News* of September 1, 1994, illustrates a polymer gel between a fabric layer and the skin of an amputee. The text of said advertisement indicates that the Silosheath is *impregnated* with the gel, and only one fabric ply is depicted in the cross-sectional view. In the examiner's opinion, the ordinary practitioner would have interpreted the advertised product as having a gel that penetrates through the fabric ply so as to form a coating (however minute) on the outer surface of the fabric. Moreover, optimizing the overall gel thickness (including that portion which impregnates the fabric) would enhance the stated function of dispersing "shock and vibration on the surface of the residual limb and eliminate skin breakdown" and would improve the comfort of the device. Nowhere does the advertisement mention a relatively low friction fabric surface, as does the Applicant's teaching at column 10, line 60, through column 11, line 13, of US 5,830,237. Therefore, the advertisement has not been applied to the present claims under 35 U.S.C. 102 or 35 U.S.C. 103(a).

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 78, 134, 143, 152, and 161 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the

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claimed invention. Although the claimed range is suggested (US 5,830,237: column 7, lines 5-7) for the knee sleeve (open at both ends), such is not the case for the presently claimed cushion liner having open and closed ends.

Claims 75-77, 80, 85, 88, 89, 92-94, 96, 99, 102, 103, 106, 107, 110, 111, 114, 115, 118-121, 124-133, 135-142, 144-151, 153-160, and 162-165 are allowed.

The Applicant's remarks have been considered. The Applicant asserts that "the 10-25 inch length recited in each of rejected claims 78, 134, 143, 152 and 161 is within [the] stated range [1-30 inches] and is, consequently, supported by the specification. Applicant simply elected to claim a narrower range of lengths" (Applicant's reply of May 2, 2007: page 13, line 20, through page 14, line 1). Narrowing the claims by introducing elements or limitations not supported by the as-filed disclosure is a violation of the written disclosure requirement of 35 U.S.C. 112, first paragraph (MPEP § 2163.05, section II). Neither 10 inches nor 25 inches is found in the original disclosure as an example or as a range endpoint for the length of the cushion liner as claimed, so the Applicant may not "carve out" such a narrowed range from the broader range of 1-30 inches presented in the specification (MPEP § 2163.05, section III). Attention is also directed to the very first sentence in MPEP § 2163.05.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse, whose telephone number is 571-272-4762 and who is generally available Monday, Tuesday, and Thursday, and sometimes on Wednesday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Dave Willse
Primary Examiner
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